

REMARKS

Claims 1-12 have been examined and have been rejected under 35 U.S.C. § 102(e).

I. Preliminary Matters

On page 2 of the Office Action, the Examiner acknowledged receipt of priority papers under 35 U.S.C. § 119(a)-(d). However, the Examiner did not check the appropriate boxes on the Office Action Summary. Accordingly, Applicant respectfully requests that the Examiner check the appropriate boxes under item #13 in the next Office Action.

The Examiner has objected to the drawings because they include reference numerals which are not disclosed in the specification. For example, the Examiner maintains that reference numerals 21C and 21N, shown in Fig. 2A, are not disclosed in the specification. Accordingly, Applicant has amended the specification to include the reference numerals 21C and 21N. Applicant submits that such amendments overcome the objection.

II. Rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 6,469,796 to Leiman et al. (“Leiman”).

Claims 1-12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Leiman.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited references. For example, claim 1 recites a printer having a storage for storing a document file to be printed. The document file is received from a computer.

The Examiner maintains that server spool 126 (incorrectly referred to as #26 on pg. 3 of the Office Action) of Leiman discloses the claimed storage (Fig. 5). Server spool 126 is a direct access storage device (col. 5, lines 4-7). However, as shown in Fig. 5 of Leiman, server spool 126 is provided in open print server 52, rather than in one of printers 62. For example, open print server 52 routes print jobs, which are sent from source computer 116, over a local area network to an output manager 60 (Fig. 5; col. 3, lines 53-56). The output manager 60 then has the jobs printed on printers 62 (Fig. 5; col. 3, lines 56-57). Thus, even if Applicant assumes *arguendo* that server spool 126 discloses the claimed storage, Leiman fails to teach or disclose that server spool 126 is provided in printer 62, as required by claim 1.

Claim 1 also recites a printer having a configuration file generator for employing print setup information in the document file, which is received from the computer. The configuration file generator generates a configuration file concerning a print setup for the document file.

The Examiner maintains that queue manager 128 discloses the claimed configuration file generator (Fig. 5). The queue manager 128 receives a status of all incoming print jobs, and accesses print resources, i.e. fonts, page definitions, etc. (col. 5, lines 8-10 and 35-47). However, Leiman fails to disclose that queue manager 128 generates any type of file, i.e. claimed generation file. Further, as shown in Fig. 5 of Leiman, queue manager 128 is provided in open print server 52, rather than one of printers 62. Thus, even if Applicant assumes *arguendo* that queue manager 128 discloses the claimed configuration file generator, Leiman fails to teach or disclose that the queue manager 128 is provided in printer 62, as required by claim 1.

Claim 1 further recites a printer having a print setup reference means for employing the configuration file to generate a menu indicating contents of the print setup, and for transmitting the menu to the computer.

The Examiner maintains that the claimed print setup reference means is disclosed in column 7, lines 17-25 of Leiman. Based on the portion cited by the Examiner, Applicant assumes the Examiner maintains that the graphical user interface (GUI) 130 discloses the claimed print setup reference means (Fig. 5; col. 5, lines 21-25 and col. 7, lines 1-25). However, similar to Applicant's statements above, even if Applicant assumes *arguendo* that GUI 130 discloses the claimed print setup reference means, Leiman fails to teach or disclose that the GUI 130 is provided in printer 62, as required by claim 1.

In light of the above, Applicant submits that claim 1 is patentable over the cited reference.

B. Claims 2 and 3

Since claims 2 and 3 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 4

Since claim 4 contains features which are analogous to the features recited in claim 1, Applicant submits that such claim is patentable over the cited reference for at least analogous reasons.

D. Claim 5

Since claim 5 contains features which are analogous to the features recited in claim 1, Applicant submits that claim 5 is patentable over the cited reference for at least analogous reasons as presented above for claim 1.

E. Claims 6 and 7

Since claims 6 and 7 are dependent upon claim 5, Applicant submits that such claims are patentable at least by virtue of their dependency.

F. Claim 8

Since claim 8 contains features which are analogous to the features recited in claim 1, Applicant submits that such claim is patentable for at least analogous reasons as presented above.

G. Claims 9, 10 and 11

Since claims 9, 10 and 11 are dependent upon claim 8, Applicant submits that such claims are patentable at least by virtue of their dependency.

H. Claim 12

Since claim 12 contains features which are analogous to the features recited in claim 1, Applicant submits that such claim is patentable for at least analogous reasons as presented above.

Amendment under 35 U.S.C. § 1.111
U.S. Application No. 09/487,728

III. Newly added claims

Applicant has added claims 13-18 to provide more varied protection for the present invention.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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